

**REMARKS****I. General**

Claims 1-42, 45-94, 96-98, and 101-108 are pending, and all are rejected by the Office Action mailed February 8, 2006. Claims 1, 45-47, 75, 96, 98, and 101 are amended hereby. Claims 43, 44, 95, 99, 100 and 109 are canceled without prejudice. The issues in the current Office Action are as follows:

- Claims 1, 3, 75, 76, 87, 105, 106, and 108 are rejected under 35 U.S.C. §102(e) over US Patent Application Publication 2004/0203539 (hereinafter, *Benes*).
- Claims 38-43, 46, 69, 91-94, and 109 are rejected under 35 U.S.C. §102(e) over US 6,148,211 (hereinafter, *Reed*).
- Claims 2 and 86 are rejected under 35 U.S.C. §103(a) over *Benes* in view of US 5,581,260 (hereinafter, *Newman*).
- Claims 4-9, 27-31, and 88-90 are rejected under 35 U.S.C. §103(a) over *Benes*.
- Claim 10 is rejected under 35 U.S.C. §103(a) over *Benes* in view of US 6,865,395 (hereinafter, *Riley*).
- Claims 11-21, 24-26, 32-37, 77-85, and 107 are rejected under 35 U.S.C. §103(a) over *Benes* in view of *Reed*.
- Claim 22 is rejected under 35 U.S.C. §103(a) over *Benes* in view of *Reed* in further view of *Riley*.
- Claims 47-49, 59-68, 70-74, and 102-104 are rejected under 35 U.S.C. §103(a) over *Reed*.
- Claims 44-45 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Riley*.

- Claims 50-55 and 95-101 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Benes*.
- Claims 56-58 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Benes* in further view of *Riley*.

Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the amendments and remarks contained herein.

## II. Claim Amendments

Claim 1 has been amended to recite, in part, “calculation logic for determining receive signal strength differences of a signal, said signal received using said multiple antenna patterns.” The amendment is a clarifying amendment for cosmetic purposes only and does not change the scope of the claim. Further, this amendment is not in response to any art. Thus, no new matter is added.

Claim 38 has been amended to include the limitations of claim 44 and intervening claim 43. Since the amendment rewrites claim 44 in independent form, it does not narrow the scope of claim 44. No new matter is added.

Claim 75 has been amended to recite, in part, “determining receive signal strength differences of a signal, said signal received using said multiple antenna patterns.” The amendment is a clarifying amendment for cosmetic purposes only and does not change the scope of the claim. Further, this amendment is not in response to any art. Thus, no new matter is added.

Claim 91 has been amended to include the limitations of claim 100 and intervening claims. Since the amendment rewrites claim 100 in independent form, it does not narrow the scope of claim 100. No new matter is added.

Claims 45-47 are amended to depend from claim 38, and claims 96, 98, and 101 are amended to depend from claim 91. No new matter is added.

### III. Claim Rejections Under 35 U.S.C. §102

#### A. Rejections over *Benes*

On pages 2-5 of the Office Action, claims 1, 3, 75, 76, 87, 105, 106, and 108 are rejected under 35 U.S.C. §102(e) over *Benes*. Applicant traverses the rejection.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for an applied reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). As discussed further below, these requirements are not satisfied by the 35 U.S.C. § 102 rejection because *Benes* does not teach every element of the claims.

Claim 1 recites, in part, “calculation logic for determining receive signal strength differences of a signal, said signal received using said multiple antenna patterns.” *Benes* does not teach at least this feature of claim 1. The Office Action cites the passage at paragraph 0027 to teach the feature; however, such assertion is incorrect because *Benes* does not teach a signal received using multiple antenna patterns, as claimed. Note that paragraphs 0026 and 0027 teach using downlink signals 802 and 804 to calculate an angle of arrival. The two downlinks signals are received by a mobile station, but it is not taught that either of the signals are received by the mobile station using multiple antenna patterns. Therefore, *Benes* does not teach a signal received using multiple antenna patterns and does not teach this feature of claim 1.

Claim 75 recites, in part, “determining receive signal strength differences of a signal, said signal received using said multiple antenna patterns.” *Benes* does not teach at least this feature of claim 75. As explained above, *Benes* does not teach a signal received using multiple antenna patterns. Note that paragraphs 0026 and 0027 teach using downlink signals 802 and 804 to calculate an angle of arrival. The two downlinks signals are received by a mobile station, but it is not taught that either one of the signals are received by the mobile station using multiple antenna patterns. Thus, *Benes* does not teach this feature of claim 70.

Claim 108 recites, in part, “a channel model independent determination algorithm utilizing receive signal strength differences between multiple receive antenna patterns.” *Benes* does not teach utilizing multiple receive antenna patterns. Note that paragraphs 0026 and 0027 teach using downlink signals 802 and 804 to calculate an angle of arrival. The two downlinks signals are received by a mobile station, but it is not taught that the mobile station utilizes multiple receive antenna patterns. It is unclear from the Response to Arguments on page 2 of the Office Action why the rejection of claim 108 was maintained. Thus far, there is no clear reasoning in the rejection to show utilizing multiple receive antenna patterns as claimed. Thus, *Benes* does not teach this feature of claim 108.

Dependent claims 3, 76, 87, and 106 each depend either directly or indirectly from respective independent claims 1, 75, and 105 and, thus, inherit all of the limitations of their respective independent claims. Thus, *Benes* does not teach all claim limitations of claims 3, 76, 87, and 106. It is respectfully submitted that dependent claims 3, 76, 87, and 106 are allowable at least because of their dependence from their respective base claims for the reasons discussed above. Accordingly, withdrawal of the rejection of claims 1, 3, 75, 76, 87, 105, 106, and 108 is respectfully requested.

#### **B. Rejections over *Reed***

Claims 38-43, 46, 69, 91-94, and 109 are rejected under 35 U.S.C. §102(e) over *Reed*. Claims 43 and 109 are canceled. Applicant traverses the rejection.

Amended claim 38 includes the limitations of dependent claim 44 and recites, in part, “location estimation logic for determining an estimated location of said device from an intersection point of arcs projected identified distances from said wireless network access node and said second wireless network access node.” Since claim 38 rewrites claim 44 in independent form, the rejection of claim 44 is addressed herein. The Office Action rejects claim 44 as obvious over *Reed* in view of *Riley*. The combination does not teach or suggest the above-recited feature of claim 38 because neither reference teaches determining an estimated location from intersection point of arcs. The Office Action admits that *Reed* does not teach or suggest the feature and, instead, relies on *Riley* to teach or suggest the feature. *Riley* does not teach or suggest the above recited feature. The Office Action cites figure 2

and the description thereof to show the feature. Figure 2 and the description thereof teaches sectorized cells and a wireless terminal. See *Riley* at Col. 4, line 40 through Col. 5, line 31. The passage mentions estimating a wireless terminal's position; however, it does not teach such estimating is performed from an intersection of arcs. Thus, the passage does not teach or suggest "location estimation logic for determining an estimated location of said device from an intersection point of arcs projected identified distances from said wireless network access node and said second wireless network access node," as recited by claim 38.

Accordingly, the cited combination does not teach the above-quoted feature of claim 38.

Further, the combination of *Reed* and *Riley* is without proper motivation in the rejection of claim 44. The Office Action fails to provide the requisite motivation to combine *Reed* with *Riley*. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 21 of the Office Action the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method of estimating location of a device from an intersection point of vector projected from the wireless network access node because this is one of the desirable methods in determining the location.

The statement is circular in that it asserts that it is obvious to add the missing part to *Reed* in order to have a system that includes the missing part. In arguing this, the Office Action fails to suggest the desirability for such a modification. Such language is merely a statement that the references can be modified, and does not state any desirability for making the modifications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper.

Amended claim 91 includes the limitations of claim 100 and recites in part, "wherein a one of said position estimates is used to confirm the other of said position estimates." The Office Action rejects claim 100 as obvious over *Reed* in view of *Benes*. Since amended

claim 91 rewrites claim 100 in independent form, the rejection of claim 100 is addressed herein. The Office Action does not rely on *Benes* to teach or suggest the feature, nor does it appear that *Benes* teaches or suggests the feature. Instead, the Office Action relies on *Reed* at Col. 1, lines 1-21 to teach or suggest the feature. The cited passage describes a desire to locate users who are making calls; however, the cited passage does not teach or suggest confirming one position estimate with another. Accordingly, the cited combination does not teach the above-quoted features of claim 91.

Dependent claims 39-43, 46, 69, and 92-94 each depend either directly or indirectly from respective independent claims 38 and 91 and, thus, inherit all of the limitations of their respective independent claims. Thus, *Reed* does not teach all claim limitations of claims 39-43, 46, 69, and 92-94. It is respectfully submitted that dependent claims 39-43, 46, 69, and 92-94 are allowable at least because of their dependence from their respective base claims for the reasons discussed above. Accordingly, withdrawal of the rejection of claims 38-43, 46, 69, and 91-94 is respectfully requested.

#### **IV. Claim Rejections Under 35 U.S.C. §103**

##### **A. Rejections over *Benes* in view of *Newman***

Claims 2 and 86 are rejected under 35 U.S.C. §103(a) over *Benes* in view of *Newman*. Applicant traverses the rejection.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any criteria, Applicant respectfully asserts that the rejection does not satisfy the first and third criteria, as discussed further below.

### 1. Lack of motivation to combine

The Office Action fails to provide the requisite motivation to modify *Benes* with *Newman*. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 8 of the Office Action the Examiner states:

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to use multiple narrow antenna patterns and a wide antenna pattern to compute or determine antenna gain differences because in order to compute the antenna gain differences, it would require at least two different antenna patterns to take into considerations, and that is a multiple narrow beam, and a wide beam. It is also obvious to one skilled in the art that the antenna gain differences could be stored on any computer-readable medium such as non-volatile memory, or a database.

In other words, the rejection states that it is obvious to modify *Benes* to calculate a gain difference between a wide pattern and a narrow pattern because calculating differences requires at least two patterns. However, the rejection fails to assert why one of ordinary skill in the art would be motivated to modify *Benes* to calculate gain differences specifically using a wide pattern and a narrow pattern. Further, the cited portion *Newman* does not suggest the desirability for the modification—it merely describes problems in producing full sector coverage. Such language is merely a statement that the references can be modified, and does not state any desirability for making the modifications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 2 and 86 fails.

### 2. Failure to teach or suggest all claimed limitations

Claims 2 and 86 depend from claims 1 and 75, respectively. As shown above, claims 1 and 75 are patentable over the rejections of record. Nothing in the rejections of claims 2 and 86 cures the deficiency in the rejections of the respective base claims. Accordingly, it is

respectfully submitted that claims 2 and 86 are patentable at least because of their dependence from claims 1 and 75.

#### B. Rejections over *Benes*

Claims 4-9, 27-31, and 88-90 are rejected under 35 U.S.C. §103(a) over *Benes*. Applicant traverses the rejection.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See M.P.E.P. § 2143.* Without conceding the second criterion, Applicant respectfully asserts that the rejection does not satisfy the first and third criteria, as discussed further below.

##### 1. Lack of motivation to modify

In rejecting claims 27-31 and 88-90, the Office Action fails to provide the requisite motivation to modify *Benes* as proposed. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 10 of the Office Action the Examiner states:

However, it is obvious to one skilled in the art that once a location of the device is identified or determined, then one skilled in the art would be able to utilize the location information to beam or deliver information, advertisement to the particular device or user. Furthermore, based on the location determination, then one skilled in the art would be able to have a control over it. Hence, a security logic, location-based access security logic for providing levels of access to wireless, content delivery logic for providing content, or management logic for providing management are solely a design decision; and therefore, it is obvious to one skilled in the art, and it is not novel.

In other words, the Office Action tries to avoid specifying any motivation by asserting that the features recited by claims 27-31 and 88-90 are mere design choices. However, such features are not properly dismissed. Where a claimed structure and the function it performs are different from the prior art, it is improper to find that such features are a design choice. *In*

*re Chu*, 36 U.S.P.Q.2d 1089, 1095 (Fed. Cir. 1995), *citing In re Gal*, 980 F.2d 717, 25 U.S.P.Q.2d 1076 (Fed. Cir. 1992). In this case, each of claims 27-31 and 88-90 recite a function, such as, for example, providing network access, data content, management of network resources, preventing access, providing levels of access, etc. Claims 27-31 additionally recite structures. Such structures and functions are not taught or suggested in the cited art, and further, the cited art makes no suggestion why one would be motivated to modify *Benes* as proposed. Accordingly, the recited features are not mere design choices, and the Office Action provides no other motivation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 27-31 and 88-90 fails.

## 2. Failure to teach or suggest all limitations

Claims 4-9, 27-31, and 88-90 depend from claims 1 and 75, respectively. As shown above, claims 1 and 75 are patentable over the rejections of record. Nothing in the rejections of claims 4-9, 27-31, and 88-90 cures the deficiency in the rejections of the respective base claims. Accordingly, it is respectfully submitted that claims 4-9, 27-31, and 88-90 are patentable at least because of their dependence from claims 1 and 75.

Further, claims 27-31 and 88-90 include features that are novel in their own right because they are not taught or suggested by *Benes*, as modified. In rejecting each of claims 27-31 and 88-90, it appears that the Office Action asserts that each of the features well-known in the art by dismissing such features as design choices. It is believed that such statement is Official Notice by the Office that the features of the claims are known. Such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. §2144.03(B). However, the rejections do not include such reasoning, as explained below.

For instance, in rejecting claims 27-31 and 88-90, the Office Action states, “once a location of the device is identified or determined, then one skilled in the art would be able to utilize the location information to beam or deliver information, advertisement to the particular device or user.” However, such statement tries to paraphrase claimed features and simply assert obviousness without providing any reasoning. Further, the rejection states, “based on the location determination, then one skilled in the art would be able to have a control over it.” However, there is no reasoning provided that explains what kind of control is had over the device or how or why such control is possible. Then, the rejection simply asserts that security logic, content delivery logic, and management logic are obvious. Once again, however, there is no technical reasoning. Since the requisite sound technical and scientific reasoning is not provided, such Official Notice is improper. Accordingly, the cited combination does not teach or suggest the recited feature of claims 27-31 and 88-90.

While Applicant has traversed the contents of the Official Notice, Applicant further respectfully requests that the Examiner provide an affidavit or publication supporting such Notice under M.P.E.P. § 2144.03(C) if the Examiner believes such features are well-known. For these reasons, withdrawal of the rejections of claims 4-9, 27-31, and 88-90 is respectfully requested.

### C. Rejections over *Benes* in view of *Riley*

Claim 10 is rejected under 35 U.S.C. §103(a) over *Benes* in view of *Riley*. Applicant traverses the rejection.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any criteria, Applicant respectfully asserts that the rejection does not satisfy the first and third criteria, as discussed further below.

1. Failure to teach or suggest all claim limitations

Claim 10 depends from claim 1. As shown above, claim 1 is patentable over the rejections of record. Nothing in the rejection of claim 10 cures the deficiency in the rejection of claim 1. Accordingly, it is respectfully submitted that claim 10 is patentable at least because of its dependence from claim 1.

2. Lack of motivation to modify

The Office Action fails to provide the requisite motivation to combine *Benes* with *Riley*. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 11 of the Office Action, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method of estimating location of a device from an intersection point of vector projected from the wireless network access node because this is one of the desirable methods in determining the location.

In other words, the Office Action states that the feature is desirable because “it is one of the desirable methods.” The statement is circular in nature and fails to explain why one of ordinary skill in the art would be motivated to make such a modification. Such language is merely a statement that the references can be modified, and does not state any desirability for making the modifications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 10 fails.

**D. Rejections over *Benes* in view of *Reed***

Claims 11-21, 24-26, 32-37, 77-85, and 107 are rejected under 35 U.S.C. §103(a) over *Benes* in view of *Reed*. Applicant traverses the rejection.

Claims 11-21, 24-26, 32-37, 77-85, and 107 depend from claims 1, 38, 75, and 105, respectively. As shown above, claims 1, 38, 75, and 105 are patentable over the rejections of record. Nothing in the rejections of claims 11-21, 24-26, 32-37, 77-85, and 107 cures the deficiency in the rejections of the respective base claims. Accordingly, it is respectfully submitted that claims 11-21, 24-26, 32-37, 77-85, and 107 are patentable at least because of their dependence from claims 1, 38, 75, and 105.

**E. Rejections over *Benes* in view of *Reed* in further view of *Riley***

Claim 22 is rejected under 35 U.S.C. §103(a) over *Benes* in view of *Reed* in further view of *Riley*. Applicant traverses the rejection.

Claim 22 depends from claim 1. As shown above, claim 1 is patentable over the rejections of record. Nothing in the rejection of claim 22 cures the deficiency in the rejection of claim 1. Accordingly, it is respectfully submitted that claim 22 is patentable at least because of its dependence from claim 1.

**F. Rejections over *Reed***

Claims 47-49, 59-68, 70-74, and 102-104 are rejected under 35 U.S.C. §103(a) over *Reed*. Applicant traverses the rejection.

**1. Lack of motivation to modify**

In rejecting claims 64-68 and 102-104, the Office Action fails to provide the requisite motivation to modify *Reed* as proposed. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 20 of the Office Action the Examiner states:

However, it is obvious to one skilled in the art that once a location of the device is identified or determined, then one skilled in the art would be able to utilize the location information to beam or deliver information, advertisement to the particular device or user. Furthermore, based on the location determination, then one skilled in the art would be able to have a control over it. Hence, a security logic, location-based access security logic for providing levels of access to wireless, content delivery logic for providing content, or

management logic for providing management are solely a design decision; and therefore, it is obvious to one skilled in the art, and it is not novel.

In other words, the Office Action tries to avoid specifying any motivation by asserting that the features recited by claims 64-68 and 102-104 are mere design choices. However, such features are not properly dismissed. Where a claimed structure and the function it performs are different from the prior art, it is improper to find that such features are a design choice. *In re Chu*, 36 U.S.P.Q.2d 1089, 1095 (Fed. Cir. 1995), *citing In re Gal*, 980 F.2d 717, 25 U.S.P.Q.2d 1076 (Fed. Cir. 1992). In this case, each of claims 64-68 and 102-104 recites a function, such as, for example, providing network access, data content, management of network resources, preventing access, providing levels of access, etc. Claims 64-68 additionally recite structures. Such structures and functions are not taught or suggested in the cited art, and further, the cited art makes no suggestion why one would be motivated to modify *Reed* as proposed. Accordingly, the recited features are not mere design choices, and the Office Action provides no other motivation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 *citing In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 64-68 and 102-104 fails.

## 2. Failure to teach or suggest all claim limitations

Claims 47-49, 59-68, 70-74, and 102-104 depend from claims 38 and 91, respectively. As shown above, claims 38 and 91 are patentable over the rejections of record. Nothing in the rejections of claims 47-49, 59-68, 70-74, and 102-104 cures the deficiency in the rejections of the respective base claims. Accordingly, it is respectfully submitted that claims 47-49, 59-68, 70-74, and 102-104 are patentable at least because of their dependence from claims 38 and 91.

Further, claims 64-68 and 102-104 include features that are novel in their own right because they are not taught or suggested by *Reed*, as modified. In rejecting each of claims 64-68 and 102-104, it appears that the Office Action asserts that each of the features well-known in the art by dismissing such features as design choices. It is believed that such

statement is Official Notice by the Office that the features of the claims are known. Such an assertion without documentary evidence may be appropriate if the Office Action provides “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. §2144.03(B). However, the rejections do not include such reasoning, as explained below.

For instance, in rejecting claims 64-68 and 102-104, the Office Action states, “once a location of the device is identified or determined, then one skilled in the art would be able to utilize the location information to beam or deliver information, advertisement to the particular device or user.” However, such statement tries to paraphrase claimed features and simply assert obviousness without providing any reasoning. Further, the rejection states, “based on the location determination, then one skilled in the art would be able to have a control over it.” However, there is no reasoning provided that explains what kind of control is had over the device or how or why such control is possible. Then, the rejection simply asserts that security logic, content delivery logic, and management logic are obvious. Once again, however, there is no technical reasoning. Since the requisite sound technical and scientific reasoning is not provided, such Official Notice is improper. Accordingly, the cited combination does not teach or suggest the recited feature of claims 64-68 and 102-104.

While Applicant has traversed the contents of the Official Notice, Applicant further respectfully requests that the Examiner provide an affidavit or publication supporting such Notice under M.P.E.P. § 2144.03(C) if the Examiner believes such features are well-known. For these reasons, withdrawal of the rejections of claims 47-49, 59-68, 70-74, and 102-104 is respectfully requested.

#### **G. Rejections over *Reed* in view of *Riley***

Claims 44-45 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Riley*. Claim 44 has been rewritten in independent form in claim 38. Accordingly, the rejection of claim 44 is addressed above with regard to claim 1. Applicant traverses the rejection of claim 45.

Claim 45 recites, in part, “location estimation logic for determining an estimated location of said device from a midpoint of positions associated with said closest matches

from said wireless network access node and said second wireless network access node.” The Office Action rejects claim 45 as obvious over *Reed* in view of *Riley*. The combination does not teach or suggest the above-recited feature of claim 45 because neither reference teaches determining an estimated location from a midpoint of positions. The Office Action admits that *Reed* does not teach or suggest the feature and, instead, relies on *Riley* to teach or suggest the feature. *Riley* does not teach or suggest the above recited feature. The Office Action cites *Reed* at column 6, lines 48-65 to show the feature. The cited passage teaches expected coverage areas of a base transceiver station. The passage does not mention or teach determining estimated location from an midpoint of positions. Thus, the passage does not teach or suggest “location estimation logic for determining an estimated location of said device from a midpoint of positions associated with said closest matches from said wireless network access node and said second wireless network access node,” as recited by claim 45. Accordingly, the cited combination does not teach the above-quoted feature of claim 45.

Further, the combination of *Reed* and *Riley* is without proper motivation. The Office Action fails to provide the requisite motivation to combine *Reed* with *Riley*. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. On page 22 of the Office Action the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a step of determining an estimated location of the device from a midpoint of positions associated with closest matches because the midpoint positions between the first and second wireless network access node could be an appropriate approximation location of the device.

In other words, the rejection states that it is obvious to include the feature because the feature could be “appropriate.” The statement is circular in that it asserts that it is desirable to add the missing part to *Reed* because it is desirable. Such language is merely a statement that the references can be modified, and does not state any desirability for making the modifications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Thus, the failure to provide motivation suggesting desirability of the modifications is improper.

#### **H. Rejections over *Reed* in view of *Benes***

Claims 50-55 and 95-101 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Benes*. Applicant traverses the rejection.

Claims 50-55 and 95-101 depend from claims 38 and 91 respectively. As shown above, claims 38 and 91 are patentable over the rejections of record. Nothing in the rejections of claims 50-55 and 95-101 cures the deficiency in the rejections of the respective base claims. Accordingly, it is respectfully submitted that claims 50-55 and 95-101 are patentable at least because of their dependence from claims 38 and 91.

#### **I. Rejections over *Reed* in view of *Benes* in further view of *Riley***

Claims 55-58 are rejected under 35 U.S.C. §103(a) over *Reed* in view of *Benes* in further view of *Riley*. Applicant traverses the rejection. The rejection of claim 100 is addressed with regard to the rejection of independent claim 91, above, since claim 91 rewrites claim 100 in independent form. Claims 95 and 99 are canceled.

Claims 56-58 depend from claim 38. As shown above, claim 38 is patentable over the rejections of record. Nothing in the rejections of claims 56-58 cures the deficiency in the rejections of the respective base claims. Accordingly, it is respectfully submitted that claims 56-58 are patentable at least because of their dependence from claim 38.

#### **V. Conclusion**

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 64032/P008US/10307656 from which the undersigned is authorized to draw.

Dated: May 5, 2006

Respectfully submitted,

By Thomas L. Kelton  
Thomas Kelton  
Registration No.: 54,214  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-7115  
(214) 855-8200 (Fax)  
Attorney for Applicant